

Application No. 10/049,694
Paper Dated: August 6, 2004
In Reply to USPTO Correspondence of April 8, 2004
Attorney Docket No. 0388-020199

REMARKS

Claims 1-9 are in the application and are amended to more positively recite Applicants' patentably novel eye drops container. Claims 10-20 are added by this Amendment to set forth Applicants' patentably novel eye drop container in varying scope. No claims are allowed.

Claims 1-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action alleges that there is insufficient structure set forth in the claims for the container to be capable of "instilling its contents by a pressing force of about 1.28 to about 3.34N". The Office Action continues by alleging that the material of the container isn't even claimed in claim 1, and it appears that Applicants are relying on the test results listed in the specification which were performed on containers with a particular material and a particular size, as well as a particular size dent portion.

Applicants respectfully traverse the rejection of claims 1-9 under 35 U.S.C. § 112, second paragraph; however, to reduce the issues, claim 1 is amended. Amended claim 1 recites an improved eye drops container. The eye drops container that is improved is of the type having a flexible cylindrical barrel portion, which requires a pressing force of about 5.35 to about 6.15N for instilling a single drop of water from the container. Applicants' improvement provides a container having at least one dent portion that can be gripped by two fingers positioned on the cylindrical barrel portion, at least one dent portion rendering the pressing force required for instilling the single drop of water to be in the range of about 1.78 to about 3.34N. Claims 2-9 are either directly or indirectly dependent on claim 1. Support for the amendment to claim 1 is found, among other places, on page 9, line 19 to page 11, line 20 of the specification. Based on the foregoing, Applicants respectfully request admittance and consideration of amended claim 1.

Amended claim 1 is presented in Jepsen format and is directed to the prior art containers that require a pressing force of about 5.35 to about 6.15N to instill one drop of water from the container. Although Applicants in the specification identified a particular container, it can be appreciated that other containers will meet the requirement of requiring a pressing force of about 5.35 to about 6.15N to instill a drop of water from the container, and Applicants' patentably novel invention is directed to those containers. Applicants have improved the prior art containers requiring a pressing force in the range of about 5.35 to

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about 6.14N to instill one drop of water from the containers by proving the containers with at least one dent portion to reduce the force to a pressing force in the range of about 1.78 to about 3.34N.

Applicants respectfully submit that amended claim 1 meets the requirements of 35 U.S.C. § 112, second paragraph, by defining the parameters of the containers by the pressing force required to instill one drop of water from the container. Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 1-9 under 35 U.S.C. § 112, second paragraph.

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as unpatentable over Japanese ‘971 in view of Japanese ‘927 for the reasons set forth in paragraph 5 of the previous Office Action, Paper No. 7. Applicants note that the two Japanese references discussed in the previous Office Action are Japanese Patent No. 57-50927 (hereinafter “JP ‘927”) and Japanese Patent No. 153975 (hereinafter “JP ‘975”). Applicants are proceeding with the understanding that Japanese ‘971 should be JP ‘975. In the event Applicants are incorrect in their conclusion, Applicants respectfully request the opportunity to show patentability of the claims over Japanese ‘971.

The Office Action alleges that JP ‘975 discloses a drop-dispensing container with opposed dent portions 4 and 5, which are substantially flat, and the Office Action concludes by alleging that to have provided such dent portions in a barrel portion of a bottle for gripping or squeezing would have been obvious in view of JP ‘927.

Applicants respectfully traverse the rejection of claims 1 and 2 under 35 U.S.C. § 103(a); however, to eliminate this issue, claim 1 is amended as discussed above. Claim 2 is amended to be consistent with amended claim 1. Support for the amendment to claim 2 is found in originally filed claim 2. Based on the foregoing, Applicants respectfully request admittance of the amendment to claim 2 and consideration of claims 1 and 2.

Applicants respectfully submit that there is no discussion in JP ‘927 and JP ‘975 that would lead one skilled in the art to combine the references. Applicants respectfully submit that the combination is made using Applicants’ disclosure. Such a combination is made using hindsight and is improper. For the sake of discussion only and not admitting that one skilled in the art would combine JP ‘927 and JP ‘975 without Applicants’ disclosure, Applicants respectfully submit that the combination would not render claims 1 and 2 obvious. More particularly, there is no discussion that using the dents of

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JP '975 with the bottle of JP '927 would reduce the pressing force required to move a drop of liquid out of the bottle. Since both Japanese references are silent on the point that a reduction of pressing force to instill a drop of liquid from the container can be realized, there can be no disclosure of Applicants' patentably novel invention as recited in claims 1 and 2.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over JP '975 in view of JP '927.

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the conventional bottle shown in Fig. 13 of the application in view of U.S. Patent No. 5,649,648 to Lier et al. (hereinafter also referred to as "Lier"). The Office Action alleges that to have merely provided finger gripping opposed recesses or dents in the conventional dropper bottle disclosed by Applicants in Fig. 13, for controlled dispensing of the contents would have been obvious in view of such teaching by Lier (see item 6 of Fig. 2 of Lier, the Office Action notes the concave profile of Lier).

Applicants respectfully traverse the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over the conventional bottle shown in Fig. 13 of the application, in view of Lier, and request reconsideration thereof.

Claim 1 has been discussed above.

Lier discusses in column 2, lines 51 to 65 that the circular cross sections are used to allow for slight deformation of the aluminum container. More particularly, Lier discloses that without the slight deformations, pressing the sides of the aluminum container would deform the sides. There is no basis for one skilled in the art of containers for eye drops to look to the teachings of Lier that relates to aluminum containers. More particularly, squeezing a plastic bottle designed to meter out drops of eye medication would not lead one skilled in the art to use the teachings of Lier relating to squeezing an aluminum container. Nor would one skilled in the art of making eye drops containers use the circular cross sections of Lier because they are provided to avoid deforming the aluminum container while applying pressing force. These problems are not associated with the bottle shown in Fig. 13 of the drawing. Clearly, the combination of Lier and Fig. 13 is made using hindsight.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over the conventional bottle shown in Fig. 13 of the application, in view of Lier.

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Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claim 1 above and further in view of U.S. Patent No. 2,688,424 to Keiter (hereinafter “Keiter”). The Office Action alleges that Keiter teaches the use of indents or recess at 28, for example, in plastic bottles, and that the indents may have other profiles as shown at 50 and 68 in Keiter. The Office Action concludes by alleging that to have formed the indent with a flat profile or concave profile would have been obvious in Keiter teaching such alternate profiles.

Applicants respectfully traverse the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claim 1 above and further in view of Keiter.

Claims 2 and 3 are dependent on claim 1. Claims 1 and 2 were discussed above. Claim 3 is amended to be consistent with amended claim 1 on which it is indirectly dependent. Support for the amendment to claim 3 is found, among other places, in amended claim 1. Based on the foregoing, Applicants respectfully request admittance of the amendment to claim 3 and reconsideration of claims 2 and 3.

Applicants have shown above that one skilled in the art would not consider the combination of Lier with the bottle of Fig. 13 and, even if one skilled in the art did consider such combination, there would be no teaching in the combined references of reducing the pressing force required to instill a drop of fluid. Keiter does not cure the defects of Lier. An artisan considering the three pieces of prior art, more particularly, Fig. 13, Lier, and Keiter, without the knowledge of the disclosure of Applicants’ invention would at best combine only Keiter and Lier, and the combination would not disclose a dent portion on the sidewall of containers to reduce the pressing force to move a drop of water out of the container. Since there is no discussion of reducing the pressing force in Lier and Keiter, there can be no disclosure of Applicants’ invention as recited in claims 2 and 3.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claim 1 above and further in view of Keiter.

Claims 4, 5, and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claims 1, 2, and 3, respectively above, and further in view of U.S. Patent No. 5,624,057 to Lifshey (hereinafter “Lifshey”). The Office Action alleges that

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to have formed the container by the well-known practice of form, fill and seal would have been obvious in view of such teaching by Lifshey.

Applicants respectfully traverse the rejection of claims 4, 5, and 6 under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claims 1, 2, and 3, respectively above, and further in view of Lifshey. However, to reduce the issues, claims 4-6 are amended to be consistent with claim 1 on which they are dependent. Support for the amendments to claims 4-6 are found, among other places, in amended claim 1. Based on the foregoing, Applicants respectfully request admittance and reconsideration of claims 4-6. Claim 1 was discussed above.

Claim 1, on which claims 4-6 are dependent, recites that the container is made with dents to reduce the pressing force required to extract a drop of water. There is no discussion in any of the references of a container having dents that reduce the pressing force to the range recited in claim 1. Therefore, there can be no teaching in Lier, Keiter, and Fig. 13 that would lead one skilled in the art to use the disclosure of Lifshey. Further, even if the combination was made, there is no disclosure as recited in claim 1 of a container having dents to reduce the pressing force to 1.78 to 3.34N to instill a drop of water.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claims 1, 2, and 3, respectively above, and further in view of Lifshey.

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of U.S. Patent No. 5,356,052 to Poynter (hereinafter also referred to as “Poynter”). The Office Action alleges that to have formed the bottle of blow molded polyethylene would have been obvious in view of Poynter in the teaching of blow molding a drop dispenser bottle from polyethylene. The Office Action continues by alleging that it is well known in the molding art that the amount of plastic required to form a container will be dependent on a number of factors, such as desired container size and wall thickness. The Office Action concludes by alleging that Applicants have not set forth any particular size and that the selection of the amount of polyethylene is considered to be an obvious matter of choice.

Applicants respectfully traverse the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Poynter. However, to eliminate this issue, claim 7 is amended to be consistent with

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amended claim 1 discussed above. Support for the amendment to claim 7 is found, among other places, in amended claim 1. Based on the foregoing, Applicants respectfully request admittance and consideration of claim 7.

Applicants have shown above that the applied references against claim 1 do not teach a container having dent portions that reduce the pressing force to instill a drop of water to a pressing force in the range of 1.78 to 3.34N. Poynter does not cure the defects of the art applied against claim 1. More particularly, Poynter fails to teach adding dents or how dents can be added to reduce the pressing force required to instill a drop of water from the container.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claim 7 as being unpatentable over the references as applied to claim 1 above, and further in view of Poynter.

Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the bottle of Fig. 13 in view of Lier in the manner applied to claim 1 above.

The Office Action alleges that the prior art container appears to be of the size claimed in claim 8 as reported in the test results. The Office Action continues that, in any event, the dimensions are considered to be a matter of choice dependent on the volume of contents to be packaged and that, in like manner, the size of the recess is considered to be a matter of choice dependent in part on the container size and volume to be instilled. The Office Action concludes by alleging that the particular selection would have been an obvious matter of choice.

Applicants respectfully traverse the rejection claims 8 and 9 under 35 U.S.C. § 103 (a) as being unpatentable over the bottle of Fig. 13 in view of Lier in the manner applied to claim 1 above and request reconsideration thereof.

Claims 8 and 9 are dependent on claim 1. Claims 8 and 9 are amended to be consistent with amended claim 1. Support for the amendments to claims 8 and 9 is found, among other places, in claim 1. Based on the foregoing, Applicants respectfully request admittance and consideration of claims 8 and 9. Claim 1 and Lier were discussed above.

Applicants respectfully submit that particular selections in certain instances can be a matter of choice. However, the Office Action has failed to show that there is any art which shows that one skilled in the art would reduce the pressing force required to extract liquid from an eye drops container. The Office Action has selected art that shows containers

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having depressions and made out of aluminum. The Office Action has failed to show any reference that would lead one skilled in the art to believe that eye drops can be controlled and the bottle balanced using the dents to dispel the eye drops. These features are recited directly and indirectly in the claims and are not shown in any of the references taken alone or in combination.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over the bottle of Fig. 13 in view of Lier in the manner applied to claim 1 above and request allowance of claims 1-9.

Applicants, by this Amendment, have added new claims 10-20. Claims 10-16 are either directly or indirectly dependent on claim 1; claim 18 is dependent on independent claim 17; and claim 20 is dependent on independent claim 19. Support for new claims 10-20 is found, among other places, in the claims on file, in the drawings, and the specification, e.g., but not limited to pages 10 and 11. The arguments to patentably distinguish claims 1-9 over the art of record are applicable, among others, to patentably distinguish claims 10-20 over similar art.

Based on the foregoing, Applicants respectfully request admittance, consideration, and allowance of claims all of claims 10-20.

This Amendment represents a sincere effort to place this case in condition for allowance. In the event issues remain, the Examiner is invited to call the undersigned before further action is taken on the case.

Respectfully submitted,

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